

REMARKS

Claims 1-30 are presented for examination.

SUMMARY OF RESTRICTION REQUIREMENT

The Office Action restricted the claims into Groups I and II, where Group I (Claims 1-28) is drawn to a compound of formula (II) and a pharmaceutical composition comprising a compound thereof, and Group II (Claims 29-30) is drawn to a method of using the compounds according to claim 1 for the treatment of a disorder mediated by Cathepsin K. As the basis for the restriction, the Office Action alleged a serious search and examination burden due to the divergent variables in the compound of formula (II).

The Office Action further required an election of a single compound as the elected species for initial search purposes. If Group II is selected, the Office Action further required an election of a single disclosed disease.

PROVISIONAL ELECTION

Group I, consisting of Claims 1-28, is elected with traverse. Example 8.19 is further elected as the species of compound. In the present specification, Example 8.19 is disclosed on page 69 of the International Application 4-[2-(4-Methyl-piperazin-1-yl)-thiazol-4-yl]-benzoic acid.

TRAVERSAL

The restriction is traversed, because a *prima facie* case of restriction has not been established. The Office Action restricts the claims between composition claims and claims for a method of using the composition. The basis for the restriction was not that these two groups would require divergent searches but rather that the scope of the compounds was too broad so as

to cause a serious search and examination burden. (Office Action at pages 3-4). Thus, any divergent search was not alleged to be due to difference between the compound and a method of use, and the examination burden may be alleviated by electing a species of compound from the disclosed embodiments, which was also required by the Office Action. The claims track each other, and search for one group necessarily encompasses the search for the other group.

In light of the foregoing, reconsideration of the restriction requirements is requested and all Groups and species be examined together. Little is saved by separate consideration and repetitive searches. Rejoinder is further requested upon allowance.

Respectfully submitted,
HAHN & VOIGHT PLLC

/Frederick F. Calvetti/

Attorney for Applicants
Frederick F. Calvetti
Reg. No. 28,557